UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,727	07/28/2000	Philip R. Krause		3920

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/628,727	KRAUSE ET AL.
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 June 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: response to the non-final office

action of application filed on 07/28/00 which is a continuation of the application

09/015,660 filed on 01/29/98, now US Pat No. 6,154,757, domestic priority 1/29/97.

2.   Claims 1-22 are pending in the case. Claims 1, 21, and 22 are independent

claims.

3.   The rejections of claims 1-5, 7-18, 20-22 under 35 U.S.C. 103(a) as being

unpatentable over Bates have been withdrawn in view of Applicant's arguments.

4.   The rejections of claims 6 and 19 under 35 U.S.C. 103(a) as being unpatentable

over Bates and further in view of Carter have been withdrawn in view of Applicant's

arguments.

5.   The rejections of claims 6 and 19 under 35 U.S.C. 103(a) as being unpatentable

over Bates and further in view of Kierman have been withdrawn in view of Applicant's

arguments.

6.   Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Powell as applied to claim 1 above, and further in view of Bates have been withdrawn in

view of Applicant's arguments.

Priority

7.   Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

The instant application has the claimed priority to provisional application 60/036,305,

filed 1/29/97.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-5, 7-13, 20-22 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Powell et al., *Library News -- Engineering, Mathematics, & Physical*

Sciences Libraries, Cornell University May/June 1995, pages 1-6.

<u>Notes</u>: The Examiner also provides two screen shots of the Powell document that

disclose the limitations of claims 2-3, 7-8, 11.

Regarding independent claim 1, Powell discloses:

- presenting, on a display controlled by the computer system, and outline of the

    text (**pages 1-6**: the table of content is the outline of the followed text document)

    wherein:

a word or phrase appearing in the text is an element of the text (**page 1**:

the word "publish" or the phrase "how to publish information on a World

Web Server" is an element of the text)

a plurality of elements of the text are included as elements of the outlines

(**pages 1-6**: elements of the text such as Class Offering, Journal Review

Underway, Thanks, GEOROM: Geophisics on CD-ROM, etc., are

elements of the table of content, which is the outline of the text)

each element of the outline represents a portion of the text (**pages 1-2**:

each element of the table of content such as Class Offering, Journal

Review Underway, etc. represents a portion of the text)

elements of the outline comprise substantially less text than the entire text

(**pages 1-6**: the whole table of content is less text than the entire text

document)

substantially all portions of the text are represented by at least one

element of the outline_(pages 1-6)

the positional relationship between the elements of the text is maintained

on the outline (**pages 1-6**: the fact that the order of the portions of the text

followed the order disclosed in the table of content indicates that the

elements of the text is maintained on the table of content, according to the

table of content order)

- performing, in response to a signal from a user of the computer system, an

operation on the entire portion of the text represented by at least one element of

the outline (**pages 1-6**: it was well known in the art that when a user can click on an element of the table of content, which is correspondent to a signal from a user, to select a desired portion of the text, the system will effect on the entire text by moving the current cursor to the selected portion of the text and display said portion on the current display)

Powell does not disclose that the hierarchical relationship between the elements of the text is maintained on the outline.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have to have modified Powell to include the hierarchical relationship among the elements to Powell since it was well known that the outline or the table of content of a document can be expandable by adding elements of the sub-levels to include more contents for the document.

Regarding claims 2 and 3, which are dependent on claim 1, Powell discloses providing the ability to select an element in the outline, such that the operation is performed on the entire portion of text referred to by the element and displaying the result of the operation on the text represented by an element of the outline in a location on the outline corresponding to the element (two screen shots: show that when selecting an element of the Table of Contents such as Class Offering, the system will display in a window starting with the selected portion Class Offering in the text referred to by the selected element in the Table of Contents).

Regarding claim 4, which is dependent on claim 1, Powell discloses that the elements of

text presented on the outline relate to the structure of the text (**pages 1-6**: the fact that

the order of the elements of text such as Class Offering, Journal Review Underway, etc.

presented on the table of content is the same as the order of the elements of the table

of content indicates the relation between the structure of the text and the structure of the

table of content, which is the outline).

Regarding claim 5, which is dependent on claim 1, it was obvious that the table of

content in Powell is computer generated (page 1).

Regarding claim 7, which is dependent on claim 1, Powell discloses that the portion of

the outline shown at any given time correspondents to the cursor location in the original

text (**pages 1-6**: since it was well known that internal links in a hypertext document link

to a selected portion of the same hypertext document, the elements of the outline, which

are the internal hyperlinks, when selected will make the current cursor point to the

correspondent to the linked portion in the text; two screen shots: show that when

selecting an element of the Table of Contents such as Class Offering, the system will

display in a window starting with the selected portion in the text referred to by the

selected element in the Table of Contents).

Regarding claim 8, which is dependent on claim 1, Powell discloses providing a link to

the original text from a result displayed on the outline (**pages 1-2**: the table of content

contains the hypertext link Class Offering which is a link to link to the Class Offering

portion in the original text document).

Regarding claims 9 and 10, which are dependent on claims 3 and 9 respectively, Powell

does not disclose the reverse-indexing of the text referred to by the outline element

where the words in the reverse-index are provided in alphabetical order.

However, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Power to include the alphabetical order to the

index of the text since the alphabetical order was a well known way for indexing items in

managing databases and an existing index can be reversed by sorting in descending

order).

Regarding claim 11, which is dependent on claim 1, Powell discloses searching within

the text referred to by the outline element (screen shots, pages 1-2: the fact that when

selecting element "Class Offering" in the Table of Contents, the system can display the

selected portion of text on a window suggests searching within the text to find out the

target location of the "Class Offering" portion).

Regarding claims 12 and 13, which are dependent on claim 2, Powell does not disclose

printing and copying the text referred to by the outline element.

However, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Powell to include printing and copying features

the text referred to by the outline element since it was well known that a portion of text can be printing or copying by highlighting said selected portion to print or to copy as desired. So, in Powell, the Class Offering portion in the text referred to by the outline element "Class Offering" in the Table of Contents can be highlighted for printing or copying.

Regarding claim 20, which is dependent on claim 1, Powell discloses partially displaying text referred to by the outline element on the outline (pages 1-6 plus the print shots to show displaying the selected portion in the text when an element of the outline is selected).

Independent claims 21 and 22 are for a computer system and a memory storage of method claim 1, and are rejected under the same rationale.

10.   Claims 6 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Powell as applied to claim 1 above, and further in view of Kierman et al. (US Pat No. 5,701,137, 12/23/97, filed 5/24/95).

Regarding claim 6, which is dependent on claim 1, Powell does not disclose providing the user the ability to expand and collapse items in the outline.

Kierman discloses providing the user the ability to expand and collapse items in the directory tree (**figures 2 and 4**: the (+) sign and the (-) next to the items in the tree allow a user to expand and collapse items in the tree correspondent to the outline).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kierman into Powell since Kierman teaches the expand and collapse features for a directory tree providing the advantage to apply the collapse and expand features to the table of content of Powell, where the table of content is a form of an outline of a document and where the table of content is extendable by adding more elements of different levels as mentioned in claim 1 above.

Regarding claim 19, which is dependent on claim 1, Powell does not disclose moving the text referred to by the outline element to a different location.

Kierman discloses moving nodes in a tree control by dragging and dropping nodes to a different location (col 9, lines 45-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Kierman into Powell since Kierman discloses moving nodes in a tree control by dragging and dropping nodes to a different location thus motivating to apply the moving feature to the table of content of Powell which is also a form of outline of a document where the elements of the table of content in Powell can be extendable to be a tree as in Kierman.

11.   Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Powell as applied to claim 1 above, and further in view of Astiz et al. (US Pat No.

6,035,330, 3/7/00, filed 3/29/96).

Regarding claim 15, which is dependent on claim 1, Powell does not disclose identifying

material related to that referred to by the outline element.

Astiz discloses identifying material related to that referred to by the outline element

(**figures 6 and 7**: the site map is considered as an outline of the web site and next to

each element of the outline, there is an icon showing that the outline element is an

HTML document, an image, or a picture, and also the state of the element, either closed

or open, which are material identified and related to the outline element).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Astiz into Powell since Astiz discloses icons or indicators

related to that referred to by the outline element to show information related to the

outline element, providing the advantage including such icons or indicators to the outline

elements of Powell for easier recognizing the type of a selected text in a long document.

Regarding claim 16, which is dependent on claim 15, Powell does not disclose using a

reference work to look up material contained in a portion of text referred to by the

outline element.

Astiz discloses using a reference work to look up material contained in a portion of text

referred to by the outline element (**figures 6 and 7**: the pointer representing the

recursive link is considered as a reference work to look up the portion THE PAST or

THE FUTURE in the unfinished book).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Astiz into Powell since Astiz discloses using indicators or

icons as a reference work to look up material contained in the portion of text referred to

by the outline element providing the advantage of applying such feature to the table of

content elements of Powell for faster looking up a desired portion in a length document.

12.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powell

as applied to claim 1 above, and further in view of Bennett et al. (US Pat No. 5,815,392,

9/29/98, filed 8/22/95).

Regarding claim 17, which is dependent on claim 1, Powell does not disclose identifying

annotations to the portion of text referred to by the outline element.

Bennett discloses identifying annotations to the portion of text referred to by the outline

element (**figures 5a-c, e-f, col 18, lines 22-37** : annotating data items within the

hierarchical structure of the tailored outline).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Rosen into Powell since Bennett discloses annotations to

the portion of text providing in the hierarchical structure of the outline providing the

advantage to include identifying said annotations to the portion of text referred to by the

elements of the table of content of Powell, which is a form of outline, for further adding

some notes explaining the outline elements or commenting the outline elements.

Allowable Subject Matter

13.   Claims 14 and 18 are objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Response to Arguments

14.   Applicant's arguments with respect to claims 1-13, 15-17, 19-22 have been

considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Bates and Carter are not qualified as prior art since the instant

application, though filed 7/28/00 and is a continuation of the application 09/015,660 filed

1/29/98, has also the priority to provisional application 60/036,305 filed 1/29/97, which is

before the effective filing dates of Bates and Carter references.

Examiner agrees.

Bates and Carter have been withdrawn from the rejections.

Powell and Kierman still disclose the claimed invention in combination with Astiz and

Bennett as in the rejections above.

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Jaremko et al. (US Pat No. 6,133,925, 10/17/00, filed 1/8/97).

Mayhew (US Pat No. 5,933,606, 8/3/99, filed 2/19/97).

Kuppusamy et al. (US Pat No. 6,769,096, 7/27/04, filed 6/24/98).

Paine et al. (US Pat No. 6,332,148 B1, 12/18/01, filed 5/30/97).

Rosen (US Pat No. 6,198,904 B1, 3/6/01, filed 2/24/98).

Jaremko et al. (US Pat No. 6,133,925, 10/17/00, filed 1/8/97).

Reichek et al. (US Pat No. 5,960,448, 9/28/99, filed 12/15/95).

16.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Examiner
Art Unit 2178
9/2/04